

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Fujino et al.
Appl. No. : 10/580,575
Filed : May 25, 2006
For : OIL-IN-WATER EMULSION
COSMETIC COMPOSITION AND
METHOD FOR PRODUCING
THE SAME
Examiner : Heyer, Dennis
Group Art Unit : 4121

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RESPONSE TO RESTRICTION/ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Restriction Requirement mailed on **March 2, 2009**, the Examiner restricted the pending claims into two inventions:

Group I (claims 1-7), drawn to an oil-in-water cosmetic composition.

Group II (claims 8-11), drawn to a method of producing an oil-in-water cosmetic composition.

In response to the Restriction Requirement, Applicants elect Group I (claims 1-7), with traverse. This election is made with traverse for the following reasons:

The Examiner alleged that Inventions I and II do not relate to a single general inventive concept under PCT Rule 13.1, because under PCT Rule 13.2, they lack the same or corresponding special technical features based on the teaching of Fujino et al. (US 2006/0286133) which allegedly teaches all of the elements comprising instant claim 1. However, the Fujino et al. publication does not qualify as prior art against the present application. The Fujino et al. reference is the publication of the US national phase of a PCT application which was

published in Japanese. Because the PCT application was published in a language other than English, the filing date of the PCT application does not establish a date under 35 USC 102(e). Moreover, the Fujino reference is the publication of an application that is assigned to the same entity as the present invention. Thus, the application cannot qualify as prior art under 35 USC 102(e) for this additional reason. The reference clearly does not qualify as prior art under 35 USC 102(a) or 102(b), as it was published after the effective US filing date of the present application, which was established on November 25, 2004 by filing of the international application. Thus, this publication does not qualify as prior art under any circumstances.

The PCT publication corresponding to the Fujino et al. publication cited by the Examiner was published on November 18, 2004 as Publication No. WO 2004/098544. This date is only one week before the present application's PCT filing date of November 25, 2004. Thus, WO 2004/098544 does not qualify as prior art under 35 USC 102(b). Moreover, it does not qualify as prior art under 35 USC 102(a) because the present application has two Japanese priority dates before its date of publication. WO 2004/098544 also does not qualify as prior because it does not represent the work of another. It names as inventors three of the four inventors named in the present application. By definition, the fourth inventor in the present application necessarily contributed to subject matter present in the claims of the present application, but not claimed in the Fujino et al. application. Accordingly, any disclosure in WO 2004/098544 that overlaps with the presently claimed invention was necessarily the work of the same inventors. As such, WO 2004/098544 cannot qualify as prior art under 35 USC 102(a). Accordingly, none of the disclosure present in the Fujino et al. publication cited by the Examiner can qualify as prior art with respect to the claims of the present application.

Thus, the oil-in-water emulsion cosmetic composition recited in all of the claims does indeed constitute a "special technical feature" under PCT Rule 13.2, and the restriction requirement should be withdrawn. Accordingly, reconsideration and withdrawal of the Restriction Requirement with respect to Inventions I and II are respectfully requested.

Election of Species

The Examiner alleged that the application contained claims directed to more than one species, and required an election of species. Since Group I was elected in response to the Restriction Requirement, the Examiner is requiring election of the species listed on pages 4-5 of

the Restriction Requirement. In response to the Election of Species Requirement, Applicants elect polyglycerin oleate as the single component compound A (polyglycerin (trade name Great Oil D-10) in Analysis Example 1 as the polyglycerin compound, and oleic acid as the fatty acid compound), liquid paraffin as the single oily component compound B, that component D is absent, that a thickener is absent, and cream in general as the form species in claim 7. All of the claims in Group I, i.e. Claims 1-7, read upon the elected species.

Please charge any additional fees, including fees for additional extensions of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/1/09

By: 

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